

the element was a critical factor to the granting of allowance of the Cullen claims; and that the non-existence of the element or any variation of that element in Applicant's claims renders Applicant's claims patentably distinct from the Cullen patent claims. Note the  
5 cautionary statement of MPEP §804 at 800-11:

"Domination and double patenting should not be confused. They are two separate issues. One patent or application 'dominates' a second  
10 patent or application when the first patent or application has a broad or generic claim which fully encompasses or reads on an invention defined in a narrower or more specific claim in another patent or application. Domination  
15 by itself; i.e., in the absence of statutory or non-statutory double patenting grounds, cannot support a double patenting rejection."

20 The Examiner has indicated and Applicant agrees that the rules for determining double patenting apply also to determining whether a §131 Affidavit is appropriate to remove a patent as a reference. In view of the missing element from Applicant's claims, the Cullen patent claims and Applicant's claims are not identical and not  
25 subject to double patenting under 35 USC §101. Applicant's claims clearly can be literally infringed without literally infringing the Cullen patent claims. From MPEP §804 (800-11):

"'Same invention' means identical subject  
30 matter. [cases cited] A reliable test for double patenting under 35 USC §101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. In Re  
35 Vogel, 422 F2d 438, 164 USPQ 619 (CCPA 1970).

The only possible grounds for claiming double patenting is

based on obvious-type double patenting. Obvious-type double patenting is defined in the MPEP §804 starting at 800-12. As stated therein:

5 "Any obvious-type double patenting rejection should make clear:

10 (1) the difference between the inventions defined by the conflicting claims - a claim in the patent compared to a claim in the application; and

15 (2) the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in the claim in the patent."

20 "When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art."  
25 (Emphasis mine)

30 The invention claimed is the total combination of elements or steps and whatever difference exists, that difference has to be considered a difference of variation, i.e., the total invention defined is the same and differs only in obvious variations. The invention of the patent includes an element (the reel or pipe support element) that is not found in the claim of the application. That element was critical to the allowance of the Cullen patent claim. Without the element as specifically recited in the claim,  
35 the claim was not allowable to Cullen. It is axiomatic that a claim with the element and a claim without the element cannot be considered the same patentable invention. Applicant includes no limitation that can be considered a variation of the reel or pipe

holding element and as the total of the elements make up the patentable invention, the claimed invention of the application is not an obvious variation of the claimed invention of the Cullen patents.

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The CAFC has addressed this same situation at great length in General Foods v. Studiengefellschaft Kohle MbH, 972 F2d 1272, 23 USPQ 2d 1839 (CAFC 1992). (Note that this case among many other cases of the CAFC is cited as authority in the MPEP, e.g., this case is cited at page 800-14.)

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In this General Foods' case, there was a prior patent referred to as a caffeine recovery patent (the '619 patent) which included a Claim 1 consisting of nine steps. A second patent (being challenged for double patenting) is referred to as a decaffeination patent (the '639 patent). All of the steps of Claim 1 of the '639 patent were encompassed by the nine step process claim of the '619 patent, i.e., the difference is that the original patent claims included all the steps of the '639 patent plus an additional step(s). At page 1278 of the F2d cite, the Court held:

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"Claim 1 of the '619 patent, relied on to show double patenting, defines a 9 step process of 'obtaining caffeine from green coffee'. Anything less than a process with all 9 steps is not what is claimed, and is therefore, not patented."

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"Clearly the two patents do not claim the same invention, and this is not argued. Under an obviousness-type double patenting analysis, neither claimed process is a mere obvious

variation of the other. No other kind of 'double patenting' is recognized, so there is no double patenting."

5            "If the rejected claim defines more than an obvious variation, it is patentably distinct. (Underlining mine)

10           Clearly the claims of the present application claim more than an obvious variation of the Cullen patent claims. Applicant's claims have no structure that provides for a pipe or conduit support. The Cullen file wrapper demonstrates that the pipe support was essential to allowance of the Cullen claims. Cullen  
15 first tried to obtain allowance without the pipe support and was rejected. He added a broad limitation to a pipe support and was again rejected. He added further restrictions that clarified that the pipe support was distinguished from the "positioning means" which even then was only allowed following a further Examiner's  
20 Amendment "to more clearly read over the prior art". Clearly the Cullen Examiner emphatically and unquestionably considers this reel or pipe support element to provide a patentable difference.

             In the Examiner's Office Action, he cites Aelony v. Arni, 192  
25 USPQ 486 to support his position of "same invention". However, in that case there was not a missing element. From page 490:

30           "In the specific facts before us, both parties carry out the same process in which a conjugated diene material reacts with impurities according to the Diels-Alder reaction, followed by distillation of the target compound, pure malononitrile. The cyclopentadiene of Aelony, et al and eight  
35 conjugated dienes of Arni, et al are all

common Diels-Alder dienes (see note 2, supra),  
a fact not disputed in this proceeding. In  
the absence of evidence to the contrary, we  
view cyclopentadiene and the eight dienes of  
Arni, et al as patentably indistinct as  
employed in the purification method of the  
counts. We conclude that both parties are  
claiming the same inventive concept, and  
accordingly there is an interference in fact."

Here the issue was one of obvious variation and it was held  
that Aelony's cyclopentadiene was patentably indistinct from Arni's  
eight dienes and thus the parties are claiming the same inventive  
concept. This case, if anything, supports Applicant's position.  
The process was the same for both parties except Aelony used  
cyclopentadiene in the claim process whereas Arni's used any of  
eight dienes. The court first determined if these "different"  
elements were equivalents and upon finding they were, held the  
claimed inventions to be the same.

Inferentially, had there been no element to equate with the  
eight dienes of Arni, Aelony's claimed invention would not be  
considered the same as the Arni claimed invention. Clearly this  
case is distinguished from the Applicant's situation and from the  
situation of the General Foods' case cited above.

The above case is an interference case and Applicant believes  
it appropriate to consider whether Applicant's Claim 6 would  
qualify for provoking an interference with Claim 1 of Cullen '910.  
The Examiner is urged to consider how these claims could qualify  
for interference when there is no counterpart in Claim 6 to the

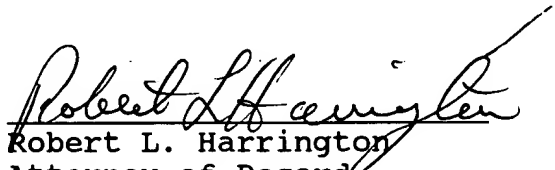
pipe support element of the Cullen patent. Applicant submits, clearly it would not qualify. If it does not qualify for interference purposes, it does qualify for §131 purposes. From "Chisum on Patents" at 3-139 to 140.1:

"In 1988, in response to the Eickmeyer decision, the Patent and Trademark Office amended Rule 131 to provide that the standard of identity of invention, which precludes use of a Rule 131 affidavit or declaration to avoid a prior art reference, is the same as that used for determining interference."

Whereas the above comments are directed to apparatus Claim 6 (and dependent Claim 9), the method Claims 1-5 are distinct for the same reasons, i.e., there is no counterpart to the pipe holding element of the Cullen claims. Still further, Claim 1 of the present application requires the step of connecting the conduit to a media source which has no counterpart in the Cullen claims. Even more so than in Claim 6, the process Claims 1-5 cannot be considered the same invention as the invention as set forth in the Cullen patents.

Enclosed herewith for the Examiner's convenience is a copy of General Foods v. Studiengesellschaft Kohle MbH, 972 F2d 1272.

Respectfully submitted,

  
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CERTIFICATE OF MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as First Class Mail, in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on the date indicated below.

Date Nov. 9, 1985

  
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